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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,927	12/21/2000	Dave Snowdon	D/99630	2867

7590 07/17/2006

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EXAMINER	
MILIA, MARK R	

ART UNIT	PAPER NUMBER
2625	

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/745,927	SNOWDON ET AL.	
	Examiner	Art Unit	
	Mark R. Milia	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-6,10,11 and 13-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-6,10,11 and 13-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 4/25/06 and has been entered and made of record. Currently, claims 1, 3-6, 10-11, and 13-20 are pending.

Response to Arguments

2. Applicant's arguments filed 4/25/06 have been fully considered but they are not persuasive.

Particularly, Ostrover discloses a processor for updating and modifying the recorded information in digital form located within an external computing device, which may be located in a printer or copier. Ostrover also discloses that the electronic copy of the document is stored in the microchip in a "standard file format" such as TIFF (see column 4 lines 47-65). It is well known in the art that TIFF files contain metadata. Further most programs that create documents, including Microsoft Word, save metadata pertaining to the document. The metadata can contain the name of the person who created the file, the name of the person who last edited the file, how many times the file has been printed, and even how many revisions have been made to the file. Porter discloses a particular use for an iButton. The iButton can be used to store information, such as photographs and textual information, which later can be retrieved and used as

desired. It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the microchip of Ostrover with the iButton described by Porter. The iButton contains a memory and a processor capable of updating and modifying information. The reference of Porter was used to show that iButtons are well known in the art and can be used to store information relating to physical information. Therefore Ostrover and Porter are combinable because they both deal with storing digital information in a microchip type device.

Therefore, the rejection of claims 1, 3-6, 10-11, and 13-20, as cited in the previous Office Action, is maintained and repeated in this Office Action.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 3, 5, 10, 11, 13, 15-17, and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover (US 6585154) in view of Porter (US 6533171).

Regarding claim 1, Ostrover discloses a programmable document comprising a physical document including at least one sheet of material and information recorded thereon (see column 4 lines 27-29 and 43-45), and a computer attached to the physical document, wherein the computer includes an input/output device, a memory storing the recorded information in digital form, any updates and modifications to the recorded information, all metadata pertaining to the physical document, wherein the metadata

comprises at least one of processing information, version information, user comments, copy information, transformation information, distribution information and index information (see column 4 line 43-column 5 line 21, reference states that the data may be in a standard file format in which the examples listed inherently have metadata, such as TIFF files, and also states that the microchip may contain an indicator that indicates when the data has been altered), a processor for updating and modifying the recorded information in digital form and the metadata pertaining to the physical document (see column 3 lines 38-42 and 63-67, column 4 lines 1-13 and 46-67, and column 5 lines 1 and 15-20), and a computer program, stored in the memory, for implementing defined actions, operable by the processor, wherein the recorded information in digital form and all metadata pertaining to the physical document is available where the physical document is available (see column 4 lines 44-65, column 5 lines 9-21, and column 6 lines 15-41).

Ostrover does not disclose expressly that the processor and the computer program are located within the microchip. Rather the processor and the computer program are located with the external computing device, i.e. a computer, printer, or copier.

Porter discloses an iButton that is capable of storing business card information as well as an individuals interests, curriculum vitae, a photograph, or other useful information (see column 5 lines 1-7).

Regarding claim 10, Ostrover discloses a method for managing, retrieving and processing information about a physical document and modifications to the physical

document, comprising: providing a computer, wherein the computer includes an input/output device, a processor for updating and modifying information pertaining to the physical document, and a memory (see column 3 lines 38-42 and 63-67, column 4 lines 1-13 and 46-67, column 5 lines 1-21, and column 6 lines 53-60) recording information on at least one sheet of material to generate a physical document (see column 5 lines 16-22 and 66-67 and column 6 lines 1-3), storing a digital copy of the recorded information, any updates and modifications to the recorded information, and all metadata pertaining to the physical document, wherein the metadata comprises at least one of processing information, version information, user comments, copy information, transformation information, distribution information and index information in the memory (see column 4 line 43-column 5 line 21, reference states that the data may be in a standard file format in which the examples listed inherently have metadata), storing a computer program in the memory, for implementing defined actions, operable by the processor (see column 4 lines 44-65, column 5 lines 9-21, and column 6 lines 15-41) associating the stored recorded information and metadata with the physical document (see column 6 lines 16-22), and attaching the computer to the physical document, wherein the recorded information in digital form and all metadata pertaining to the physical document is available where the physical document is available (see column 4 line 44-column 5 line 21).

Ostrover does not disclose expressly that the processor and the computer program are located within the microchip. Rather the processor and the computer

program are located with the external computing device, i.e. a computer, printer, or copier.

Porter discloses an iButton that is capable of storing business card information as well as an individuals interests, curriculum vitae, a photograph, or other useful information (see column 5 lines 1-7).

Ostrover & Porter are combinable because they are from electronic data copies of physically printed documents.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to replace the microchip of Ostrover with the iButton of Porter. The iButton and it's associated capabilities are well known in the art and therefore it would have been obvious to execute the processes, disclosed by Ostrover as being performed by the computing device, by the iButton.

The suggestion/motivation for doing so would have been to provide a low-cost low-effort solution to storing information.

Therefore, it would have been obvious to combine Porter with Ostrover to obtain the invention as specified in claims 1 and 10.

Regarding claim 3, Ostrover and Porter disclose the system discussed in claim 1, and Ostrover further discloses wherein the computer is attached to the physical document by at least one of an adhesive, a removable adhesive, a magnetic material (see column 5 lines 2-9).

Regarding claims 5 and 19, Ostrover and Porter disclose the system discussed in claim 1, and Porter further discloses a similar system that makes use of an iButton (see column 2 lines 21-25, column 4 lines 35-48, and column 5 lines 1-7).

Regarding claim 11, Ostrover and Porter disclose the system discussed in claim 10, and Ostrover further discloses performing an activity pertaining to the physical document and storing a digital record of the performed activity in the computer (see columns 4-6, reference teaches that information is recorded on a physical document, i.e. paper, and digital data is stored on a microchip that is an electronic copy of the information recorded on the physical document).

Regarding claim 13, Ostrover and Porter disclose the system discussed in claim 10, and Ostrover further discloses wherein the computer is attached to the physical document by an adhesive (see column 5 lines 2-9).

Regarding claim 15, Ostrover and Porter disclose the system discussed in claim 11, and Ostrover further discloses wherein the activity is selected from the group consisting of copying, providing comments, scanning, referencing an earlier version of the information (see columns 5 and 6, reference teaches a device which reads/writes to the microchip can be one of a printer, photocopy machine or a scanner, a photocopy or printer can be used to record information on the physical document and the digital representation of which is stored in the microchip).

Regarding claim 16, Ostrover and Porter disclose the system discussed in claim 1, and Ostrover further discloses wherein the metadata comprises at least one of an electronic copy of the information recorded on the physical document, comments by

readers of the document, state changes and edits made since the document was printed, processing information, version information, copy information, transformation information, distribution information, index information, and other miscellaneous information (see column 3 lines 60-67 and column 4 lines 1-10 and 43-64).

Regarding claim 17, Ostrover and Porter disclose the system discussed in claim 1, and Ostrover further discloses wherein the miscellaneous information comprises at least one of a document summary and key words (see column 6 lines 16-19, reference shows at least a portion of the content of the electronic copy of the physical document is stored in the memory device of the microchip which is equivalent to a document summary).

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover and Porter as applied to claim 1 above, and further in view of Klotz, Jr. (US 5459307).

Ostrover and Porter do not disclose expressly wherein the computer has a machine-readable label.

Klotz discloses a machine-readable label (see column 3 lines 54-66 and column 5 lines 1-7 and 20-33, reference teaches a machine readable file storage sheet flag which informs the system that a machine readable sheet containing digitally encoded files is going to be read).

Ostrover, Porter, & Klotz are combinable because they are from a similar problem solving area, notifying system about current document by way of a machine-readable label.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the machine-readable label of Klotz with the system of Ostrover and Porter.

The suggestion/motivation for doing so would have been to provide the ability to notify the system about the current document that is about to be read. Klotz teaches the significance of the label is to inform the system that a file storage sheet follows and in turn the system knows where to scan the page for file attribute information. By implementing this advantage into the current invention allows a "modified" (as stated by applicants) printer, photocopier, or fax machine to know when the system is going to process a document that has an attached computer and enable read/write capabilities.

Therefore, it would have been obvious to combine Klotz with Ostrover and Porter to obtain the invention as specified in claim 6.

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover and Porter as applied to claim 1 above, and further in view of Choksi (US 6477243).

Ostrover and Porter do not disclose expressly storing a URL for a digital version of the information recorded on the physical document.

Choksi discloses storing a URL for a digital version of the information recorded on the physical document (see column 3 lines 55-64, column 8 lines 49-67, and Fig. 5, reference teaches a system in which upon receiving a facsimile message a confirmation message is sent to the user notifying the user of the facsimile message and the URL where the message is located).

Ostrover, Porter, & Choksi are combinable because they are from the same field of endeavor, electronic storage of a physical document.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the larger storage space provided by a URL of Choksi with the idea of storing an electronic copy of a physical document of Ostrover and Porter.

The suggestion/motivation for doing so would have been storing electronic data corresponding to a physical document by using a URL because of the larger amount of storage space available on a network environment. Choksi points out the benefits of being able to transmit larger files by way of a message containing a URL which points to the location of a document rather than sending the file as an attachment in a e-mail message and risking the file exceeding a certain size limit and thus being stripped off the e-mail or being unable to send the attachment (see column 1).

Therefore, it would have been obvious to combine Choksi with Ostrover and Porter to obtain the invention as specified in claim 18.

7. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover and Porter as applied to claims 1 and 10 above, and further in view of Friedman (US 5417508).

Ostrover and Porter do not disclose expressly wherein the computer is attached to the physical document by a spiral binding.

Friedman discloses attaching physical documents with a spiral binding (see Figs. 1-5, column 2 lines 58-67, and column 3 lines 1-45).

Ostrover, Porter, & Friedman are combinable because they are from a similar problem solving area, attachment of multiple documents.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the attachment of documents using a spiral binding of Freidman with system of Ostrover and Porter.

The suggestion/motivation for doing so would have been to physically attach the microchip to the physical document.

Therefore, it would have been obvious to combine Friedman with Ostrover and Porter to obtain the invention as specified in claims 4 and 14.

8. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover.

Ostrover fails to explicitly disclose wherein the metadata comprises text, or portions thereof, of the information recorded on the document which has been translated into another language. However, Ostrover does state that the digital data can be in a number of different formats or languages and it is known in the art that metadata is data about data and refers to things such as origin, size, and formatting, and it is also known in the art that files or documents are changed to different formats on a regular basis for a multitude of reasons. Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention that metadata stores text, or a portion thereof, of the information recorded on the document which has been translated into another language.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached at (571) 272-7406. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mark R. Milia
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MRM

JOSEPH R. POKRZYWA
PRIMARY EXAMINER